

REMARKS

The indication that claims 8, 9, 14, 15, 23 and 24 are allowable over the prior art of record has been noted with appreciation. For the reasons which follow, it is respectfully submitted that all claims are in condition to be allowed.

Claims 1 and 25 were rejected under 35 U.S.C. 102 or 103 over Ueyama. This rejection is respectfully traversed.

It is noted that the Examiner has identified a difference between Ueyama and the claimed invention at lines 5-6 from the bottom of page 5 of the Office Action. Accordingly, a rejection based on § 102 is clearly inappropriate.

This reference teaches a filter for filtering an active material paste for an electrolytic cell electrode in which the filter is one “selected from a film, a fabric, a non-woven fabric, and a net made by using a fiber or wire which is made of a metal material, an organic material, or a composite material thereof” and in which the mesh size “is within the range of 5 μ m to 1 mm”. Col. 2, lines 10-17. This description may be sufficiently broad to be generic to the filter specified in claim 1 of the present application but a generic disclosure is insufficient under § 102. *Corning Glassworks v. Somotomo Electric U.S.A. Inc.*, 9 USPQ 2nd 1962, 1970 (Fed. Cir. 1989). Moreover, as the Office Action apparently recognized, there is no teaching or suggestion of the paste viscosity in this reference. To overcome this deficiency, the Office Action avers that the viscosity limitation of claim 1 would be inherent “for low viscous fluid such as ink or a liquidized paste as shown by Nakao et al”. However, there is no reference to viscosity in the English language abstract of Nakao and, in any event, the paste of Ueyama is not an “ink or liquidized paste as shown by Nakao et al.” but rather is a paste for making an electrolytic cell electrode. As the Examiner is aware, any assertion of inherency is not valid unless the inherency is certain and there is no basis in the instant case whatsoever for any allegations concerning the viscosity of the Ueyama paste.

The rejection under § 102 is clearly untenable. It is likewise submitted that any rejection based on § 103 of this reference is also untenable because it requires the use of hindsight to select an appropriate filter material and mesh size without any teaching or guidance from the reference, and the selection of an appropriate paste viscosity without any teachings whatsoever from the reference.

Claims 1-7, 10-13 and 16-22 have also been rejected under 35 U.S.C. 103 over Ueyama in view of Aoike. This rejection is also respectfully traversed.

Ueyama has been discussed above. Aoike relates to metallic fiber non-woven fabric sintered sheet but no reason is apparent, nor is any stated in the references, which provides a suggestion or motivation to combine these two (2) materials. While the Office Action asserts that it would be obvious to use the filter of Aoike in the filtration system of Ueyama because “both the disclosures are with the analogous arts of filtering low viscosity fluids”, being “analogous art” is legally insufficient to provide motivation, the assumption that Ueyama relates to “low viscosity fluids” has no basis whatsoever and the English language abstract of Aoike contains no indication of what constitutes a “low” viscosity.

There are numerous instances of prior art teaching aspects of filters. Why any one reference should be selected in preference to other references is not set forth in the instant Office Action. It is respectfully submitted that the situation here is simply that one reference having a generic disclosure about filtering paste has been combined for no apparent reason with another reference showing aspects of the filter. No reason for combining the references has been established or is apparent other than the use of hindsight for the explicit purpose of meeting the instant claims. That, however, is illegally insufficient.

It is respectfully submitted that a prima facie basis for rejection has not been established and withdrawal of the rejection is respectfully solicited.

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In light of all of the foregoing, it is respectfully submitted that this application is now in condition to be allowed and the early issuance of a Notice of Allowance is respectfully requested.

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Respectfully submitted,

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